

P27045.A06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: William Philip SHAOUY et al.	Confirmation No. 7307
Appln No.	: 09/810,992	Group Art Unit: 2174
Filed	: March 16, 2001	Examiner: Peng Ke
For	: IMPROVED METHOD AND APPARATUS FOR TAILORING CONTENT OF INFORMATION DELIVERED OVER THE INTERNET	

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Window, Mail Stop Appeal Brief-Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314  
Sir:

This appeal is from the Examiner's final rejection of claims 1-20 as set forth in the Final Office Action of June 3, 2005. A Notice of Appeal and a Request For Pre-Appeal Brief Review, in response to the June 3, 2005 Final Office Action, was filed on November 3, 2005.

Please charge the requisite fee under 37 C.F.R. 41.20(b)(2) in the amount of \$ 500.00 for the filing of the Appeal Brief and the fee in the amount of \$1,020.00 for a three-month extension of time to Deposit Account No. 09-0457. No additional fee is believed to be required for filing the instant Appeal Brief. However, if for any reason a necessary fee is required for consideration of the instant paper, authorization is hereby given to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 09-0457.

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**(I) REAL PARTY IN INTEREST**

The real party in interest is International Business Machines Corporation by an assignment recorded in the U.S. Patent and Trademark Office on March 16, 2001, at Reel 011656 and Frame 0248.

**(II) RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

**(III) STATUS OF THE CLAIMS**

Claims 1-20 stand finally rejected. Claims 1-20 are pending and are part of this appeal. The claims in issue are attached in the "Claims Appendix".

**(IV) STATUS OF THE AMENDMENTS**

A response under 37 C.F.R. § 1.116 (incorrectly labeled as Rule 1.111) was filed July 19, 2005, requesting reconsideration of the finally rejected claims. The Examiner responded with an Advisory Action dated October 18, 2005, indicating that the request for reconsideration was considered, but did not place the application in condition for allowance. Appellant submits that no other amendments after final rejection have been filed and that all amendments to the claims have been entered.

**(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**

**A. The Claimed Subject Matter**

**1. INDEPENDENT CLAIM 1**

With reference to paragraphs [0016] – [0038] of the instant published application 2002/0130902 and to the figures, and by way of non-limiting example, the invention

provides for a method for tailoring information (see paragraph [0023]) to characteristics of an information user (105), comprising: a) passing (see paragraph [0021]) a request object (200) containing at least one profile element (205A-205N) to an arbiter (310); b) actively selecting (see paragraph [0021]), by analysis of the at least one profile element (205A-205N), a personalization engine from a plurality of personalization engines (325A-325M) by the arbiter (310), the arbiter (310) refining and altering a selection (see paragraphs [0026] and [0038]) based on a number and type of the profile element (205A-205N); and c) accessing (see paragraph [0022]) a content database (335) to retrieve a personalized content object (210) identified by the personalization engine (325') selected by the arbiter (310).

## **2. INDEPENDENT CLAIM 8**

With reference to paragraphs [0016] – [0038] of the instant published application 2002/0130902 and to the figures, and by way of non-limiting example, the invention provides for an apparatus for tailoring information (see paragraph [0023]) to characteristics of an information user (105), the apparatus comprising: a) an arbiter (310) for accepting and analyzing (see paragraph [0026]) a request object (200), the arbiter (310) refining and altering a selection based on a number and type of at least one profile element (205A-205N) contained in the request object (200); and b) a plurality of personalization engines (325A-325M) for selecting (see paragraph [0021]) at least one personalized content object (210) from a content database (335); wherein the arbiter (310) selects a personalization engine (325') from the plurality of personalization engines (325A-325M), and the selected personalization engine (325') selects the at

least one personalization content object (210) from the content database (335).

### **3. INDEPENDENT CLAIM 18**

With reference to paragraphs [0016] – [0038] of the instant published application 2002/0130902 and to the figures, and by way of non-limiting example, the invention provides for a method for tailoring information (see paragraph [0023]) delivered to a user (105), comprising: an arbiter (310) selecting (see paragraph [0021]) a personalization engine (325') by analysis of at least one profile element (205A-205N); and the personalization engine (325') selecting a personalized content object (210) to tailor information (see paragraph [0023]) provided to the user (105).

### **(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**Whether claims 18-20 are improperly rejected under 35 U.S.C.**

**§ 102(a) as unpatentable over document Forecast Pro Product Description (hereafter "FORECAST PRO").**

**Whether claims 1, 2, 4, 6, 8, 9 and 12-17 are improperly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,313,921 to KADOWAKI in view of FORECAST PRO.**

**Whether claims 3, 5, 10 and 11 are improperly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,313,921 to KADOWAKI in view of FORECAST PRO, further in view of U.S. Patent No. 6,044,376 to KURTZMAN, II.**

**Whether claim 7 is improperly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,313,921 to KADOWAKI in view of**

**FORECAST PRO, further in view of U.S. Patent No. 6,064,980 to JACOBI et al., and U.S. Patent No. 6,556,963 to TETZLAFF.**

**(VII) ARGUMENT RE. 102(a) REJECTION**

**REJECTION OF INDEPENDENT CLAIM 18 UNDER 35 U.S.C. § 102 IS IN ERROR**

The rejection of claim 18 under 35 U.S.C. § 102(a) as being anticipated by FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Independent claim 18 recites a method for tailoring information delivered to a user, comprising: an arbiter selecting a personalization engine by analysis of at least one profile element; and the personalization engine selecting a personalized content object to tailor information provided to the user.

Appellant submits that FORECAST PRO is not prior art usable against the instant application and does not disclose each and every feature of claim 18.

The Examiner asserts that a prior art publication date of no later than December 31, 2000 has been established for FORECAST PRO (see Advisory Action of October 18, 2005). This assertion is not correct. While the Examiner has alleged that a duplicate copy of the on-line publication of FORECAST PRO has been identified by Wayback Machine as early as December 6, 2000, the Examiner has failed to provide evidence of the noted duplicate copy. Appellant submits that the Examiner has not established a publication date for FORECAST PRO which is earlier than Appellant's filing date of March 16, 2001.

The Examiner also asserts that FORECAST PRO discloses an arbiter which selects a personalization engine by analysis of a profile element and that the personalization engine selects a personalized content object to tailor information provided by the user. In particular, the Examiner alleges that the expert system of FORECAST PRO constitutes the arbiter, the data entered by the user constitutes the profile element and that the forecasting technique selected by FORECAST PRO constitutes the personalization engine (see page 2 of the Final Office Action).

Appellant disagrees. Claim 18 requires, among other things, an arbiter, a personalization engine, and a personalized content object having a profile element. By way of non-limiting example, Fig. 3 shows the arbiter 310 and the personalization engine 325A-325C. Fig. 2A shows the personalized content object 200 having one or more profile elements 205A-205N. Such features are not disclosed in FORECAST PRO. For example, the Examiner is not correct that the expert system disclosed in FORECAST PRO can be characterized as the recited arbiter. Claim 18 requires that the arbiter select a personalization engine by analyzing at least one profile element. The expert system in FORECAST PRO, on the other hand, merely analyzes data and "selects the appropriate forecasting technique". An expert system is not an arbiter and a forecasting technique is not a personalization engine. By way of non-limiting example, an arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification). Furthermore, a personalization engine is a type of engine which decides how information is tailored (see page 7, lines 5-9 of the specification).

The Examiner is also not correct that the forecasting technique disclosed in FORECAST PRO can be characterized as the personalized content object which has the at least one profile element. By way of non-limiting example, the instant specification describes the personalized content object 210 as comprising information tailored to the advantage of the user or the application program (see page 5, lines 15-23). The disclosure of FORECAST PRO, on the other hand, does not contain any language explaining that the forecast technique includes information tailored to the advantage of the user or the application program.

Because FORECAST PRO fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of this document renders anticipated the combination of features recited in at least independent claim 18.

**REJECTION OF DEPENDENT CLAIM 19 UNDER 35 U.S.C. § 102 IS IN ERROR**

The rejection of claim 19 under 35 U.S.C. § 102(a) as being anticipated by FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 3 of the Final Office Action, the Examiner cites item 1 of FORECAST PRO as disclosing that the arbiter receives a request object from a user, and sends the selected personalized content object to the user's application program.

Appellant respectfully disagrees. The cited language of item 1 merely discloses that the disclosed forecasting program uses a built-in expert selection system to analyze data and select an appropriate forecasting technique. The Examiner has



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simply failed to explain how such language discloses that an arbiter receives a request object from a user, and sends the selected personalized content object to the user's application program. Appellant also submits that dependent claim 19 is allowable at least for the reason that this claim depends from allowable claim 18.

Because FORECAST PRO fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of this document renders anticipated the combination of features recited in at least dependent claim 19.

**REJECTION OF DEPENDENT CLAIM 20 UNDER 35 U.S.C. § 102 IS IN ERROR**

The rejection of claim 20 under 35 U.S.C. § 102(a) as being anticipated by FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 3 of the Final Office Action, the Examiner cites item 5 of FORECAST PRO as disclosing that the arbiter receives a profile element from a profile database.

Appellant respectfully disagrees. The cited language of item 5 merely discloses that the disclosed forecasting program imports data in a variety of formats. The Examiner has simply failed to explain how such language discloses that an arbiter receives a profile element from a profile database. Appellant also submits that dependent claim 20 is allowable at least for the reason that this claim depends from allowable claims 18 and 19.

Because FORECAST PRO fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of this

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document renders anticipated the combination of features recited in at least dependent claim 19.

### **(VIII) ARGUMENT RE. 103(a) REJECTIONS**

#### **REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Independent claim 1 recites a method for tailoring information to characteristics of an information user, comprising: a) passing a request object containing at least one profile element to an arbiter; b) actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element; c) accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter.

On page 4 of the Final Office Action, the Examiner asserts that KADOWAKI teaches passing a request object containing at least one profile element to an arbiter (claim 1) at col. 18, lines 38-61 of KADOWAKI.

Appellant respectfully disagrees. The cited language of KADOWAKI merely states the following:

When a description designating personalization is found in a print job, as shown

in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job. The apparatus ID information 64-2 uniquely identifies the corresponding apparatus. More specifically, the network address of the printer controller 41 is used. The machine type ID information 64-3 identifies the machine type of printer by a number, e.g., 1 for a type X printer of a company A, 2 for a type Y printer of the company A, and 3 for a type Z printer of a company B. The machine type group ID information 64-4 identifies the machine type group by a number, e.g., 1 for a copying machine, 2 for a facsimile apparatus, and 3 for a printer. The user ID information 64-5 uniquely identifies the current user who has transmitted a print job currently being processed. The password 64-6 authenticates whether the user who has transmitted a print job is a user who is authorized to use the printer. This password 64-6 is acquired as a part of user ID information described in a print job.

Appellant fails to see the relevancy of the above-noted language. Clearly, such language is entirely unrelated to passing a request object containing at least one profile element to an arbiter or to an arbiter that selects a personalization engine from the plurality of personalization engines by analyzing the at least one profile element. A printer controller is not an arbiter. An arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification).

The Examiner also asserts that KADOWAKI teaches selecting a personalization engine from a plurality of personalization engines with an arbiter at col. 15, lines 41-45 of KADOWAKI.

Appellant respectfully disagrees. The cited language of KADOWAKI merely states the following:

The second difference from the first embodiment is the use of a plurality of personalizing servers. That is, a certain user acquires personalizing information

from a personalizing server 3-1, and another user acquires personalizing information from a personalizing server 3-2.

Again, Appellant fails to see the relevancy of the above-noted language. Clearly, such language is silent with regard to using an arbiter to selecting a personalization engine from a plurality of personalization engines. Again, an arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification).

The Examiner further asserts that KADOWAKI teaches accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter at col. 18, line 63 to col. 19, line 1 of KADOWAKI.

Appellant respectfully disagrees. The cited language of KADOWAKI merely states the following:

the personalizing server 3-1 first checks the user ID information and the password. If the personalizing server 3-1 authenticates that the user is an authorized user, the personalizing server 3-1 extracts personalizing information managed by itself and stored for an apparatus of that user.

Appellant also fails to see the relevancy of the above-noted language. Clearly, such language is silent with regard to accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter.

While acknowledging, on page 4 of the Final Office Action, that KADOWAKI fails to disclose actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines with an arbiter,

wherein the arbiter refines and alters a selection based on a number and type of the profile element, the Examiner nevertheless asserts that this feature is taught by FORECAST PRO.

Appellant respectfully disagrees. First, the Examiner has not established that this document is prior art for the reasons noted above. Second, while it can be argued that FORECAST PRO discloses analyzing data in order to select an appropriate forecasting technique, such disclosure is hardly suggestive of actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element. FORECAST PRO simply does not disclose this feature and bears no relationship or relevance, whatsoever, to this recited feature.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least independent claim 1.

**REJECTION OF INDEPENDENT CLAIM 8 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Independent claim 8 recites an apparatus for tailoring information to characteristics of an information user, the apparatus comprising: a) an arbiter for

accepting and analyzing a request object, the arbiter refining and altering a selection based on a number and type of at least one profile element contained in the request object; and b) a plurality of personalization engines for selecting at least one personalized content object from a content database; wherein the arbiter selects a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database.

On page 6 of the Final Office Action, the Examiner asserts that KADOWAKI teaches an arbiter for accepting and analyzing a request object at col. 18, lines 38-61 of KADOWAKI.

Appellant respectfully disagrees. Again, the cited language of KADOWAKI merely states the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job. The apparatus ID information 64-2 uniquely identifies the corresponding apparatus. More specifically, the network address of the printer controller 41 is used. The machine type ID information 64-3 identifies the machine type of printer by a number, e.g., 1 for a type X printer of a company A, 2 for a type Y printer of the company A, and 3 for a type Z printer of a company B. The machine type group ID information 64-4 identifies the machine type group by a number, e.g., 1 for a copying machine, 2 for a facsimile apparatus, and 3 for a printer. The user ID information 64-5 uniquely identifies the current user who has transmitted a print job currently being processed. The password 64-6 authenticates whether the user who has transmitted a print job is a user who is authorized to use the printer. This password 64-6 is acquired as a part of user ID information described in a print job.

Appellant fails to see the relevancy of the above-noted language. Clearly, such language is entirely unrelated to an arbiter for accepting and analyzing a request object. A printer controller is not an arbiter. An arbiter outputs a request object, and enables and selects one of the personalization engines (see page 6, lines 10-19 of the specification).

The Examiner also asserts that KADOWAKI teaches a plurality of personalization engines for selecting at least one personalized content object from a content database at col. 15, lines 41-45 of KADOWAKI.

Appellant respectfully disagrees. The cited language of KADOWAKI merely states the following:

The second difference from the first embodiment is the use of a plurality of personalizing servers. That is, a certain user acquires personalizing information from a personalizing server 3-1, and another user acquires personalizing information from a personalizing server 3-2.

Again, Appellant fails to see the relevancy of the above-noted language. Clearly, such language is silent with regard to a plurality of personalization engines for selecting at least one personalized content object from a content database.

The Examiner further asserts that KADOWAKI teaches that the arbiter selects a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database at col. 18, lines 38-44, col. 18, lines 62-67, and col. 19, lines 1-11 of KADOWAKI.

Appellant respectfully disagrees. The cited language of KADOWAKI merely

states the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1.

Upon receiving the user ID information and the like from the printer controller 41, the personalizing server 3-1 first checks the user ID information and the password. If the personalizing server 3-1 authenticates that the user is an authorized user, the personalizing server 3-1 extracts personalizing information managed by itself and stored for an apparatus of that user. The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41. As shown in FIG. 16B, the personalizing information in the second embodiment contains a cumulative number of printed sheets 65-1 of the current user, an upper-limit number of printed sheets 65-2 of the current user, an available function list 65-3 of the current user, font data 65-4 of the current user, cover sheet image data 65-5 of the current user, and form image data 65-6 of the current user. The printer controller 41 accomplishes personalization by copying this personalizing information to the storage areas 62-1 to 62-6 shown in FIG. 15B.

Appellant also fails to see the relevancy of the above-noted language. Clearly, such language is silent with regard to the arbiter selects a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database.

While acknowledging, on pages 6 and 7 of the Final Office Action, that KADOWAKI fails to disclose the arbiter refining and altering a selection based on a number and type of at least one profile element contained in the request object, wherein the arbiter selects a personalization engine from the plurality of personalization engines, the Examiner nevertheless asserts that this feature is taught by FORECAST PRO.



Appellant respectfully disagrees. First, as explained above, the Examiner has not established that this document is prior art for the reasons noted above. Second, while it can be argued that FORECAST PRO discloses analyzing data in order to select an appropriate forecasting technique, such disclosure is hardly suggestive of an arbiter refining and altering a selection based on a number and type of at least one profile element contained in the request object, wherein the arbiter selects a personalization engine from the plurality of personalization engine. FORECAST PRO simply bears no relationship or relevance, whatsoever, to this recited feature.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least independent claim 8.

**REJECTION OF DEPENDENT CLAIM 2 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 5 of the Final Office Action, the Examiner cites col. 19, lines 1-3 of KADOWAKI as disclosing the recited passing the personalized content object to an application program.

Appellant respectfully disagrees. The cited language merely discloses the following:

The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41.

Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 2 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 2.

**REJECTION OF DEPENDENT CLAIM 4 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 5 of the Final Office Action, the Examiner cites col. 2, lines 25-30 of KADOWAKI as disclosing the recited sending the request object over a communication network.

Appellant respectfully disagrees. The cited language merely discloses the following:

The present invention has been made in consideration of the above problems and has as its object to provide an image forming system in which a server, an external apparatus, and an image forming apparatus are connected via a

network and which can significantly improve the operability, an image forming apparatus, and a method of controlling the same.

Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 4 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 4.

**REJECTION OF DEPENDENT CLAIM 6 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On pages 5 and 6 of the Final Office Action, the Examiner cites col. 18, lines 38-67 and col. 19, lines 1-11 and 51-67 of KADOWAKI as disclosing the recited d) accessing a profile database that stores profile elements associated with the request object; e) retrieving from the profile database at least one profile element associated with the request object; and f) including in the request object the at least one profile element retrieved from the profile database.

Appellant respectfully disagrees. The language cited on col. 18, lines 38-67

merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job. The apparatus ID information 64-2 uniquely identifies the corresponding apparatus. More specifically, the network address of the printer controller 41 is used. The machine type ID information 64-3 identifies the machine type of printer by a number, e.g., 1 for a type X printer of a company A, 2 for a type Y printer of the company A, and 3 for a type Z printer of a company B. The machine type group ID information 64-4 identifies the machine type group by a number, e.g., 1 for a copying machine, 2 for a facsimile apparatus, and 3 for a printer. The user ID information 64-5 uniquely identifies the current user who has transmitted a print job currently being processed. The password 64-6 authenticates whether the user who has transmitted a print job is a user who is authorized to use the printer. This password 64-6 is acquired as a part of user ID information described in a print job.

Furthermore, the language cited on col. 19, lines 1-11 and 51-67 merely discloses the following:

The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41. As shown in FIG. 16B, the personalizing information in the second embodiment contains a cumulative number of printed sheets 65-1 of the current user, an upper-limit number of printed sheets 65-2 of the current user, an available function list 65-3 of the current user, font data 65-4 of the current user, cover sheet image data 65-5 of the current user, and form image data 65-6 of the current user. The printer controller 41 accomplishes personalization by copying this personalizing information to the storage areas 62-1 to 62-6 shown in FIG. 15B.

As described above, the personalizing server 3 manages personalizing information for each machine type group and exchanges personalizing information together with machine type group ID information. This allows a copying machine, a facsimile apparatus, and a printer to use a common personalizing server. Also, personalizing information inherent to each machine type group can be acquired. Furthermore, personalizing information can be acquired by using only a user ID as a personalizing key without using machine

type group ID information.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 6. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 6 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 6.

**REJECTION OF DEPENDENT CLAIM 9 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 7 of the Final Office Action, the Examiner cites col. 2, lines 25-30 and col. 19, lines 1-3 of KADOWAKI as disclosing the recited output logic for passing the at least one personalization content object to an application program over a communication network.

Appellant respectfully disagrees. The cited language of col. 2, lines 25-30 merely discloses the following:

The present invention has been made in consideration of the above problems and has as its object to provide an image forming system in which a server, an external apparatus, and an image forming apparatus are connected via a network and which can significantly improve the operability, an image forming apparatus, and a method of controlling the same.

Furthermore, the language cited on col. 19, lines 1-3 merely discloses the following:

The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 9. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 9 is allowable at least for the reason that this claim depends from allowable claim 8.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 8.

**REJECTION OF DEPENDENT CLAIM 12 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 7 of the Final Office Action, the Examiner cites col. 18, lines 39-46 of KADOWAKI as disclosing the recited selecting a personalization engine using at least one of an object-oriented analysis and an expert-system analysis process.

Appellant respectfully disagrees. The cited language of col. 18, lines 39-46 merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 12. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 12 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 12.

**REJECTION OF DEPENDENT CLAIM 13 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the

Examiner.

On page 8 of the Final Office Action, the Examiner cites col. 18, lines 39-46 of KADOWAKI as disclosing the recited expert-system analysis comprises at least one of rule based analysis, model based analysis, and knowledge based analysis.

Appellant respectfully disagrees. Again, the cited language of col. 18, lines 39-46 merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 13. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 13 is allowable at least for the reason that this claim depends from allowable claims 1 and 12.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 13.

**REJECTION OF DEPENDENT CLAIM 14 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to



reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 8 of the Final Office Action, the Examiner cites col. 18, lines 39-46 of KADOWAKI as disclosing the recited the arbiter analyzing at least one of a date of the request object, a user identity, a user shopping history, and a user usage path.

Appellant respectfully disagrees. Again, the cited language of col. 18, lines 39-46 merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 14. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 14 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 14.

**REJECTION OF DEPENDENT CLAIM 15 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over

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KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 8 of the Final Office Action, the Examiner cites col. 3, lines 5-6 and col. 19, lines 1-3 of KADOWAKI as disclosing the recited arbiter configured to receive a request object from a user and a profile element from a profile database.

Appellant respectfully disagrees. The cited language of col. 3, lines 5 and 6 merely discloses the following:

Also, the user ID preferably indicates a user who has produced the image forming information.

Additionally, the cited language of col. 19, lines 1-3 merely discloses the following:

The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 15. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 15 is allowable at least for the reason that this claim depends from allowable claim 8.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the

combination of features recited in at least dependent claim 15.

**REJECTION OF DEPENDENT CLAIM 16 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 8 of the Final Office Action, the Examiner cites col. 18, lines 39-46 of KADOWAKI as disclosing the recited at least one of an object-oriented arbiter and an expert-system arbiter.

Appellant respectfully disagrees. The cited language of col. 18, lines 39-46 merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 16. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 16 is allowable at least for the reason that this claim depends from allowable claim 8.

Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant

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submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 16.

**REJECTION OF DEPENDENT CLAIM 17 UNDER 35 U.S.C. § 103 IS IN ERROR**

The rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over KADOWAKI in view of FORECAST PRO is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

On page 9 of the Final Office Action, the Examiner cites col. 18, lines 39-46 of KADOWAKI as disclosing the recited the arbiter is configured to analyze at least one of a date of the request object, a user identity, a user shopping history, and a user usage path.

Appellant respectfully disagrees. Again, the cited language of col. 18, lines 39-46 merely discloses the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job.

It is not apparent how the above-noted language discloses or suggest the above-noted features of claim 17. Additionally, as explained above, the Examiner has not established that FORECAST PRO is prior art for the reasons noted above. Finally, Appellant submits that dependent claim 17 is allowable at least for the reason that this claim depends from allowable claim 8.

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Because the combination of the above-noted documents fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of these documents renders unpatentable the combination of features recited in at least dependent claim 17.

### **(IX) CONCLUSION**

Each of claims 1-20 are patentable under 35 U.S.C. §§ 102(b) and 103(a). Specifically, the applied art of record, even in properly combined, fails to disclose or suggest the unique combination of features recited in Appellant's claims 1-20. Accordingly, Appellant respectfully requests that the Board reverse the decision of the Examiner to reject claims 1-20 under 35 U.S.C. §§ 102(a) and 103(a), and remand the application to the Examiner for withdrawal of the above-noted rejections.

Respectfully submitted,  
William Philip SHAOUY et al.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a horizontal dashed line underneath it.

Andrew M. Calderon  
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Attachments: Claims Appendix, Evidence Appendix, and Related Proceedings Appendix

CLAIMS ON APPEAL

1. A method for tailoring information to characteristics of an information user, comprising:
  - a) passing a request object containing at least one profile element to an arbiter;
  - b) actively selecting, by analysis of the at least one profile element, a personalization engine from a plurality of personalization engines by the arbiter, the arbiter refining and altering a selection based on a number and type of the profile element;
  - c) accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter.
2. The method of claim 1, further comprising passing the personalized content object to an application program.
3. The method of claim 2, wherein the application program is a web browser.
4. The method of claim 1, further comprising sending the request object over a communication network.
5. The method of claim 4, wherein the communication network is the Internet.

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6. The method of claim 1, further comprising:

d) accessing a profile database that stores profile elements associated with the request object;

e) retrieving from the profile database at least one profile element associated with the request object; and

f) including in the request object the at least one profile element retrieved from the profile database.

7. The method of claim 1, wherein the plurality of personalization engines comprises at least two personalization engines selected from the group consisting of a rule-based personalization engine, a predictive-modeling personalization engine, and a collaborative filtering personalization engine.

8. Apparatus for tailoring information to characteristics of an information user, the apparatus comprising:

a) an arbiter for accepting and analyzing a request object, the arbiter refining and altering a selection based on a number and type of at least one profile element contained in the request object; and

b) a plurality of personalization engines for selecting at least one personalized content object from a content database;

wherein the arbiter selects a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least

one personalization content object from the content database.

9. The apparatus of claim 8, further comprising output logic for passing the at least one personalization content object to an application program over a communication network.

10. The apparatus of claim 9, wherein the communication network is the Internet.

11. The apparatus of claim 9, wherein the application program is a web browser.

12. The method of claim 1, further comprising selecting a personalization engine using at least one of an object-oriented analysis and an expert-system analysis process.

13. The method of claim 12, wherein the expert-system analysis comprises at least one of rule based analysis, model based analysis, and knowledge based analysis.

14. The method of claim 1, further comprising the arbiter analyzing at least one of a date of the request object, a user identity, a user shopping history, and a user usage path.



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15. The apparatus of claim 8, wherein the arbiter is configured to receive a request object from a user and a profile element from a profile database.

16. The apparatus of claim 8, further comprising at least one of an object-oriented arbiter and an expert-system arbiter.

17. The apparatus of claim 8, wherein the arbiter is configured to analyze at least one of a date of the request object, a user identity, a user shopping history, and a user usage path.

18. A method for tailoring information delivered to a user, comprising:  
an arbiter selecting a personalization engine by analysis of at least one profile element; and  
the personalization engine selecting a personalized content object to tailor information provided to the user.

19. The method of claim 18, further comprising the arbiter receiving a request object from a user, and sending the selected personalized content object to the user's application program.

20. The method of claim 19, further comprising the arbiter receiving a profile element from a profile database.

EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 35 U.S.C. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 35 U.S.C. §41.37(c)(ix).

NO.	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
1	N/A	N/A

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RELATED PROCEEDINGS APPENDIX

Pursuant to 35 U.S.C. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 35 U.S.C. §41.37(c)(1)(ii) are enclosed herewith.

NO.	TYPE OF PROCEEDING	REFERENCE NO.	DATE
1	N/A	N/A	N/A